

REMARKS

As a preliminary matter, Applicant traverses the outstanding Office Action in its entirety as being nonresponsive, and for mischaracterizing arguments previously made by Applicant. The Office Action repeats the same rejections from the previous Office Action, but fails to address the majority of the meritorious arguments put forth by Applicant that traversed these rejections. With respect to Applicant's repeated traversal of the outstanding restriction requirement in particular, Applicant is at a loss to understand how the Examiner can continue to assert that the previous election was made "without traverse," when in fact, the election was made with traverse, and this fact has been repeatedly pointed out to the Examiner.

As a second preliminary matter therefore, Applicant again traverses the outstanding restriction requirement imposed by the Examiner, and takes particular exception to the Examiner's intentional mischaracterization of Applicant's previous election as being made "without traverse." As previously discussed, the Examiner is free to disagree with Applicant's grounds for traversal, or even challenge the sufficiency of such grounds, and make the restriction requirement final. The Examiner is not, however, entitled to deny that fact that the election was specifically with traverse, when the record clearly indicates otherwise.

In attempting to justify this mischaracterization of Applicant's election, the Examiner asserts that Applicant "did not provide appropriate showings or evidence" that the

examination of only two additional claims (out of the original 14) “would not place an undue burden on the Examiner.” This statement represents an attempt to improperly shift the Examiner’s own burden to establish the *prima facie* case back onto Applicant. The evidence the Examiner requires is only relevant to the rebuttal of a *prima facie* case. Applicant is not required to submit any such evidence when challenging the *prima facie* case itself (which still has not been established). Applicant’s grounds for traversal challenged the sufficiency of the *prima facie* case, and were not merely a rebuttal that would require the evidence the Examiner seeks.

The Examiner still has the initial burden to establish that further examination of only these two restricted claims would place an undue burden upon him. Applicant has timely, and repeatedly, argued that the Examiner is the one who has failed to make the required showing that examining 14 claims instead of 12 would place an undue burden on him. As previously stated, the Examiner is well within his rights and authority to disagree with the grounds for traversal. The Examiner is not within his rights or authority, however, to deny that the traversal was even made. By responding to the restriction requirement in a timely manner, and by stating valid grounds for traversing the *prima facie*, Applicant has preserved the right to petition the Commissioner to overturn this improper restriction requirement. The Examiner’s repeated mischaracterization of Applicant’s election would deny Applicant this right to petition the Commissioner. Elections made “without traverse” waive the right to such a petition.

Accordingly, Applicant again submits that the outstanding Office Action must be vacated at least in order to have the record correctly reflect the legal status of Applicant's traversal of the Examiner's restriction requirement. Applicant therefore further incorporates by reference herein all of the previous Amendments and Responses traversing both the restriction requirement, as well as the substantive rejections, discussed further below. With respect to these substantive rejections, the Examiner is further invited to consider the following additional remarks that expand upon these previous arguments.

Claims 1-6 and 9-14 again stand rejected under 35 U.S.C. 103(a) based on the same combination of Furuishi (JP 2000-306226) with Higashiya (JP 06-012807). With respect to claims 1, 6, 9, and 14, these claims have been canceled, rendering the rejection of these claims now moot. With respect to the remaining claims, Applicant once again respectfully traverses this rejection for at least the reasons of record, and as follows. *A prima facie* case of obviousness has not been established against the present invention, and none of the meritorious arguments that traversed this previous rejection have been challenged.

Specifically, Applicant notes that the Examiner has not challenged, and even appears to concede, that neither of the cited references, alone or together, show a cavity located at the very rearmost portion of the head slider, as clearly claimed and illustrated in the present Application. Without challenging this discrepancy between the present claims and the prior art, the Examiner instead appears to have merely dismissed the arguments under a theory that the present claims are not "picture claims." This alleged theory though, is

irrelevant, because Applicant has never argued anything regarding any “picture claims.” What Applicant has actually argued is that neither of the references, alone or together, teach or suggest that a cavity is located between the transducer and the rearmost portion of the head slider. The misinterpretation of the plain language of the independent claims is improper, and fails to rebut these arguments.

For example, the Examiner asserts that he is interpreting the phrase “rearmost portion of the head slider” to mean *any* “section or location *near or close to* the rear” of the slider. Such an interpretation ignores, on its face, the plain language of the claims. The independent claims do not recite the cavity as being between the transducer and only a “rear portion” of the slider, but instead between the transducer and the “rearmost portion” of the slider. A rear portion of the slider may include, but will not be the same as, the rearmost portion. Applicant concedes the Examiner’s assertion that the “rearmost portion of the slider” is not strictly limited to only the rear “face” or “edge” of the slider, but the pending “rearmost” terms still require that any portion of the slider to which they refer must be more to the rear of the slider than any portion to which they are compared. All of the Examiner’s comments with respect to these limitations appear to entirely leave out any consideration of the term “-most” recited in the claims.

With respect to these clearly recited feature of the claims therefore, Applicant again further points out that the rejection still does not indicate any analogous features in the prior art. However broadly the claim language is interpreted, the rejection must still indicate

where the prior art teaches or suggests a cavity between the transducer and the portion of the slider that is *most rear* to the slider. The transducer and the rearmost portion of the slider are recited as separate and distinct elements in the claims, and according to the plain language of the claims, the rearmost portion of the slider must still be *more* toward the rear of the slider than the transducer. A “rearmost” portion of the slider could not be less toward the rear of the slider than the transducer. The rearmost portion also could not include the transducer and still be located separately from the transducer for this plain language of the claims to have any meaning.

The two cited references simply fail to show any features relevant to these plainly recited features of the present invention, and Applicant particularly notes that the rejection never even asserts that these features are taught or suggested within the cited references. The Examiner even appears to concede Applicant’s factual assertions regarding the references. For example, on page 3 of the outstanding Office Action (first full paragraph), the Examiner expressly admits that “Furuishi is silent, however, as to the head slider having a cavity on the air outlet end near the electromagnetic transducer 35 between the transducer and a rearmost portion of the head slider.” The rejection therefore, admittedly relies only upon Higashiya for teaching or suggesting any *location* to the cavity with respect to the transducer.

However, as repeatedly argued by Applicant (and not rebutted), Higashiya could not possibly teach or suggest such features as recited in the present invention, because

Higashiya does not even teach or suggest *any* location for a transducer on its slider. No person of ordinary skill in the art could reasonably interpret any element of Higashiya's slider to be between a transducer of the slider and any other portion, because Higashiya simply does not even illustrate where any such transducer might be located. The outstanding rejection should therefore be withdrawn for at least these reasons alone.

The proposed combination of Furuishi with Higashiya fails to make up for these deficiencies in the Higashiya reference. Higashiya and Furuishi require very different structures to their respective sliders. These two different structures cannot be merely superimposed on one another, as the rejection appears to assert. And even if one skilled in the art attempted to superimpose the two different structures upon one another, all of the Higashiya's recesses 1 would still be *less* toward the rearmost portion of the "combination" slider than Furuishi's transducer 35. For at least these further reasons, the rejection again should be withdrawn.

With respect to dependent 2-3 and 10-11 specifically (now all recited in independent form), Applicant further notes that the rejection fails to address almost all of the arguments traversing the rejection of the original subject matter from these claims. The Examiner does raise a question regarding one sentence (out of several pages) of the arguments traversing the rejection of these claims, but this question really does not make sense, and even if it did, it fails to address or rebut any of the other unquestioned arguments that show the clear deficiencies in the *prima facie* case asserted against all of these claims.

The Examiner's question of whether "the dimensions of the cavity vary with the formula, as opposed to the dimension of the cavity being determined or approximated by the formula," fails to shift the burden of proof back to Applicant for the obviousness rejection. The Examiner still has the burden to establish where the prior art teaches or suggests each and every feature and limitation of the claims, as required by Section 2143.03 of the MPEP. This burden still has not been met. No teaching or suggestion from either prior art reference has been cited as being analogous to either of the Examiner's grammatical interpretations of the claimed formula.

And frankly, Applicant does not understand what distinction the Examiner is attempting to make between the dimensions of the cavity "varying with," or "being determined or approximated by," the formula. The plain language of claims 2-3 and 10-11 is abundantly clear to one of ordinary skill in the art (Applicant notes here that the Examiner does not assert any rejections under Section 112), and each interpretation the Examiner puts forth still concedes that the x-, y-, and z- dimensions of the recited cavity are still dependent on the recited formulae from claims 2-3 and 10-11. In spite of Applicant's many meritorious arguments traversing the lack of any such teachings or suggestions in the cited prior art references, the Examiner still does not even assert that either reference teaches or suggests any such formulae for, or relationships between, the dimensions of the cavity.

As discussed above, the Examiner admits that Furuishi does not disclose or suggest the cavity of the present invention. Only Higashiya has been cited for these features.

Higashiya, however, does not teach or suggest any relationship between the x-, y-, and z-dimensions of its disclosed recesses 1, and therefore the *prima facie* rejection of these claims is deficient on its face.

The Examiner's brief comments comparing the present Specification to the Higashiya reference further demonstrate that these claims have not been rejected under the appropriate standard of consideration. In the last sentence on page 3 of the outstanding Office Action, Higashiya is not compared to the actual recited limitations of claims 2-3 and 10-11, but instead to a brief description *in the present Specification* regarding a depth range that the cavity of the present invention may fall within. The Examiner appears to assert that, because a preferred depth range of the present cavity is generally within the same range as the recess taught by Higashiya, the present cavity and Higashiya's recess are therefore equivalents on this basis alone. This rationale, however, improperly attempts to read limitations from the Specification into the claims.

None of claims 2-3 and 10-11 recite numerical ranges for the depth of the claimed cavity, as implied by the Examiner. Instead, each of claims 2-3 and 10-11 recites a relationship between the three (x, y, and z) dimensions of the cavity. These claimed relationships are thus structural features of the invention, and not merely numerical ranges for the dimensions. Because no such relationships have ever been identified within the Higashiya reference, and because these meritorious arguments have never been rebutted, the rejection of claims 2-3 and 10-11 should also be withdrawn for at least these reasons as well.

With respect to claims 4-5 and 12-13 (now also rewritten in independent form), the rejection of these claims should also be withdrawn for reasons similar to those discussed above with respect to claims 2-3 and 10-11. The outstanding rejection does not even comment on any of the subject matter recited in claims 4-5 and 12-13 as last amended. Nor does the rejection answer or otherwise rebut the arguments repeatedly traversing the rejection of these claims. On page 3 of the outstanding Office Action (last full paragraph) the Examiner briefly mentions one portion of claim 4 (but not claims 5 or 12-13), but this brief comment only refers to claim language that has been long since been removed from the claim, and does not address any of the language of the claim as it was last amended. Accordingly, the outstanding Office Action is entirely silent regarding the actual limitations and features of claims 4-5 and 12-13, as well as the arguments traversing the rejection of these claims. The rejection of these claims therefore should also be withdrawn.

New claims 15-20 have been added to recite other combinations of features of the present invention. All of these claims depend from one of the pending independent claims, and therefore should present no new issues requiring further search or consideration. Entry, consideration on the merits, and allowance are respectfully requested.

For all of the foregoing reasons, Applicant submits that this Application, including claims 2-5, 7-8, 10-13, and 15-20, is in condition for allowance, which is respectfully requested. The Examiner is invited to contact the undersigned attorney if yet another interview would help expedite prosecution.

Respectfully submitted,

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August 8, 2006

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